

## **REMARKS/ARGUMENTS**

### **I. General Remarks**

At the time of the Office Action, Claims 1-41 were pending. Claims 1-21 have been canceled herein. Claims 22, 24-26, 28-29, 33, 36, 39, and 41 have been amended herein. Applicants respectfully request that the above amendments be entered, and further request reconsideration in light of the amendments and remarks contained herein.

Applicants respectfully submit that these amendments add no new matter to the application and are supported by the specification as originally-filed. All the above amendments are made in a good faith effort to advance the prosecution on the merits of this case. Applicants thank the Examiner for his careful consideration of this application.

### **II. Remarks Regarding Provisional Election**

On November 2, 2006, during a telephone conversation with the Examiner, claims 22-41 were provisionally elected in response to the Examiner's restriction requirement without traverse. This provisional election is hereby confirmed, and claims 1-21 have been canceled. No amendment to inventorship is necessitated by this election. Applicants reserve the rights to subsequently take up prosecution on the claims as originally filed in this or an appropriate continuing application.

### **III. Remarks Regarding Amendments to the Specification.**

The Examiner has objected to the disclosure because there were typographical errors in paragraph [0013] of the specification. (Office Action, at page 3.) Applicants have amended the specification in this response to correct for these inadvertent typographical errors.

### **IV. Rejections of the Claims Under 35 U.S.C. § 112**

Claims 24-26, 28-34, 36, 37 and 39-41 are rejected under 35 U.S.C. § 112, as being indefinite "for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." (Office Action, at page 3.) More specifically, claims 24-26, 28-29, 33, 36, 39 and 41 are deemed indefinite "in being drawn to improper Markush groupings." Although Applicants believe that this language was sufficiently definite to meet the requirements of 35 U.S.C. § 112, Applicants have amended the Markush grouping language in these claims per the Examiner's suggestion. Therefore, Applicants respectfully request the withdrawal of this rejections.

Additionally, the Examiner has rejected claim 40 for lack of antecedent basis for “the solvent.” Applicants respectfully submit that there is sufficient antecedent basis for “the solvent.” More specifically, claim 40 states as follows: “The method of claim 38 wherein the solvent is present in an amount ranging from about 0.1% to about 60% by weight of the total corrosion inhibitor.” Claim 38 states as follows: “The method of claim 22 wherein the corrosion inhibitor further comprises a solvent.” Thus, Applicants submit that “the solvent” as recited in claim 40 does have sufficient antecedent basis, and therefore, Applicants respectfully request the withdrawal of this rejection.

**V. Remarks Regarding Rejections Under 35 U.S.C. § 102(b)**

Claims 22-31 and 38-41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,669,613 issued to Knox, *et al.* (hereinafter “*Knox*”). With respect to this rejection, the Examiner writes that:

Knox et al (note col. 1, line 59 - col. 2, line 20; col. 3, lines 36-43) discloses a process of acidizing a near wellbore region of a subterranean formation with an acidizing solution comprising an acid and a corrosion inhibitor which comprises the reaction product of a thiol compound, such as hydrogen sulfide, with an aldehyde compound, as called for in independent claim 22.

(Office Action, at pages 4-6.) Applicants respectfully disagree.

In order to form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2006). *Knox* does not disclose each and every element as set forth in independent claim 22 because *Knox* does not disclose “placing an acidizing solution in the zone of interest, wherein the acidizing solution comprises an acid and a corrosion inhibiting compound comprising the reaction product of a thiol compound and an aldehyde compound, wherein the thiol compound has the general formula RSH wherein R is not H.” Rather, *Knox* expressly discloses that “[t]he present invention provides a sulfide cracking inhibitor comprising the reaction product of an aldehyde and hydrogen sulfide in the presence of a strong acid...” (*Knox*, col. 1, lines 63-66.) Thus, because Applicants are no longer claiming that the thiol compound may be hydrogen sulfide, and *Knox* only discloses a “reaction product of an aldehyde and hydrogen sulfide,” Applicants respectfully submit that that these claims are patentable over this reference. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 23-31 and 38-41 depend, either

directly or indirectly, from claim 22, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

**VI. Remarks Regarding Rejections Under 35 U.S.C. § 103(a)**

**A. Rejections of Claims 32-34**

Claims 32-34 stand rejected under 35 U.S.C. § 103(a) as obvious over *Knox* in view of U.S. Patent No. 5,976,416 issued to Brezinski, *et al* (hereinafter “*Brezinski*”). With respect to this rejection, the Examiner writes that:

Brezinski (note col. 1, line 48 - col. 2, line 20) notes in his discussion of prior art that it is well known to employ corrosion inhibitor activators or intensifiers in combination with a corrosion inhibitor(s), with such activators typically comprising an antimony or copper salt.

Accordingly, it would have been obvious to one of ordinary skill in the art to which the invention pertains, to similarly include a conventional corrosion inhibitor activator, such as an antimony or copper chloride salt, into the acidizing process of *Knox et al*, as taught by *Brezinski*, in order to enhance or improve the overall corrosion inhibitor effectiveness in the well and/or subterranean formation, as called for in claims 32 and 33.

(Office Action, at page 7.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under § 103(a), the combination of references must teach or suggest all of the elements of the claim. MPEP § 2143. First, as discussed in Section V above, *Knox* does not teach all the elements of claim 22, from which claims 32-34 depend, because *Knox* does not, either explicitly or inherently, disclose or teach “placing an acidizing solution in the zone of interest, wherein the acidizing solution comprises an acid and a corrosion inhibiting compound comprising the reaction product of a thiol compound and an aldehyde compound, wherein the thiol compound has the general formula RSH wherein R is not H.” Similarly, *Brezinski* does not supply this missing recitation. Thus, these references do not obviate claims 32-34. Accordingly, Applicants respectfully request the withdrawal of these rejections.

**B. Rejections of Claims 35-37**

Claims 35-37 stand rejected under 35 U.S.C. § 103(a) as obvious over *Knox* in view of U.S. Patent No. 5,441,929 issued to Walker, *et al* (hereinafter “*Walker*”). With respect to this rejection, the Examiner writes that:

Walker discloses a process of acidizing a well with an acid solution comprising a corrosion inhibitor. Walker further discloses the use of a surfactant, to facilitate the dispersion of the corrosion inhibitor in the acidizing formulation.

Accordingly, it would have been obvious to one of ordinary skill in the art to which the invention pertains, to similarly add a surfactant to the acidizing formulation injected in the acidizing process of Knox et al, as taught by Walker, in order to facilitate or enhance the dispersion of the corrosion inhibitor(s) in the acidizing formulation injected, as called for in claims 35 and 36.

(Office Action, at pages 7-8.) Applicants respectfully disagree.

In order for a combination of references to form the basis for a rejection under § 103(a), the combination of references must teach or suggest all of the elements of the claim. MPEP § 2143. First, as discussed in Section V above, *Knox* does not teach all the elements of claim 22, from which claims 35-37 depend, because *Knox* does not, either explicitly or inherently, disclose or teach “placing an acidizing solution in the zone of interest, wherein the acidizing solution comprises an acid and a corrosion inhibiting compound comprising the reaction product of a thiol compound and an aldehyde compound, wherein the thiol compound has the general formula RSH wherein R is not H.” Similarly, *Walker* does not supply this missing recitation. Thus, these references do not obviate claims 35-37. Accordingly, Applicants respectfully request the withdrawal of these rejections.

#### **V. No Waiver**

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

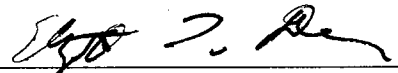
#### **SUMMARY**

In light of the above remarks, Applicants respectfully submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this

application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

The Commissioner is hereby authorized to debit the Deposit Account of Baker Botts L.L.P., Deposit Account No. 02-0383 in the amount of \$180.00 for the fee under 37 C.F.R. § 1.17(p) for consideration of an Information Disclosure Statement after mailing of the first Non-Final Office Action on the merits. Applicants believe that no additional fees are due in association with this filing. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.0401.

Respectfully submitted,



Elizabeth L. Durham  
Registration No. 59,509  
BAKER BOTTS L.L.P.  
One Shell Plaza  
910 Louisiana  
Houston, TX 77002  
Telephone: 713.229.2104  
Facsimile: 713.229.7704  
Email: liz.durham@bakerbotts.com

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